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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,109

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Wolfgang von Deyn

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EXAMINER

HOLLOMAN, NANNETTE

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

10/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,109	Applicant(s) VON DEYN ET AL.	
	Examiner NANNETTE HOLLOMAN	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 18-22 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 18-22 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' arguments, filed August 19, 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

Previous Rejection

1) Claims 15, 18-22 and 30-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Furch et al. (EP 0604798) in view of Ragusa et al. (Entomologia Hellenica, Vol. 12, 1994-1998, pp. 55-64). This rejection is partially maintained. This rejection is withdrawn in regard to claims 18, 21, 22 and 34.

Applicant's Arguments

Applicant argues Furch et al. relates to plant protection in the agricultural field and discloses the insecticidal and acaricidal activity of N-arylhydrazine derivatives and other compounds against crop pest of the *Coleoptera*, *Lepidoptera*, and *Acarina* orders.

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Applicant further argues Furch fails to disclose any of the orders listed in claims 15 and 30 and the pesticide used in the treatment of piercing-sucking or biting crop pest cannot generally be expected to show equal activity against non-crop pest who do not feed on plant parts. Applicant also argues Furch fails to teach or suggest a method of protection of cellulose-containing non-living organic materials selected from the group consisting of wooden materials and paper and does not mention anything about a bait composition. Applicant argues Ragusa does not cure the defects of Furch. Applicant's arguments have been fully considered and they are partially persuasive.

Examiner's Response

In regard to claims 18, 21, 22 and 34, the rejection is withdrawn since the references do not teach or suggest a method of protecting cellulose-containing non-living organic materials selected from the group consisting of wooden materials and paper and does not mention anything about a bait composition.

In regard to crop and non-crop pest, Applicant defines in the specification non-crop pest of the order Parasitiformes, however as taught by Ragusa mites of the superorder Parasitiformes have been found on agricultural crops and are considered predators (p. 55, column 1). Therefore, it appears Applicant's "non-crop" pest can also be found in agricultural crops, which would provide one of ordinary skill the motivation to use the method and pesticides of Furch to treat the mite of Parasitiformes of Ragusa. One would have a reasonable expectation of success, since Furch has shown pesticidal activity against mites of the subclass Acarina.

2) Claims 15, 18-22 and 27-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi et al. (Us Patent No. 5,378,726) in view of Furch et al. (EP 0604798). This rejection is maintained. This rejection is withdrawn in regard to claims 18, 21 and 22.

Applicant's Arguments

Applicant argues Yanagi nor Furch teach protection of wooden materials and paper against non-crop pest as recited in amended claim 18. Applicant further argues Yanagi does not mention combining it hydrazine derivative with amidrazones, such as those disclosed by Furch. Furthermore, if the hydrazine derivative of Yanagi were combined with the amidrazone of Furch, the combined composition would not read on the compound of formula I, since the compound of formula I comprises a single active compound and any combination would comprise more than one active compound. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response

In regard to claims 18, 21, 22 and 34, the rejection is withdrawn since the references do not teach or suggest a method of protecting cellulose-containing non-living organic materials selected from the group consisting of wooden materials and paper.

The instant claims recite the method “comprising”, which is open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03. Therefore, a combined composition comprising a compound of formula I would read on the instant claims. As previously asserted, Yanagi et al. discloses combining other pesticides with its pesticide composition to form a synergistic composition having excellent effects; wherein the other active substance includes acaricides (column 9, lines 49-65). Therefore, Yanagi provides the motivation to combine its pesticide composition with Furch’s acaricide composition to form a third composition that provides a more excellent pesticidal effect.

New Rejection

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15, 18-22 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furch et al. (EP 0604798) in view of Mitchell (Sociobiology, Vol. 40, No. 1, 2002, pp. 47-69, Abstract).

Furch et al. disclose a method for the control of insect or acarid pests which comprises contacting said pests or their food, supply, habitat or breeding grounds with a pesticidally effective amount of a compound having the structure of (I), which meets the claimed compound (Reference claim 1). Furch et al. further disclose said compounds are also effective for protecting growing or harvested crops from attack and infestation by such pests (p. 6, lines 20-23), which is being understood to meet the limitation of "non-living organic materials" of instant claim 27.

Furch et al. differ from the instant claims insofar as it does not disclose the specifically claimed orders or superorders.

Mitchell discloses termites, which are defined in the instant specification as members of the order Isoptera, having attacked a wide range of crops at all stages of the growth cycle, pose severe competition to domestic stock and game, and are responsible for severe damage to buildings and wooden structures.

Mitchell differs from the instant claims insofar as it does not disclose a method for controlling non-crop pests.

In KSR v. Teleflex, 82 USPQ2d 1385, 1397 (U.S. 2007), the Supreme Court has held that when there is market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person has good reason to pursue known options within his or her technical grasp. Under these conditions, “obviousness to try” such options is permissible. In this instance, a market pressure exists in the agricultural industries to combat non-crop pest. Accordingly, it would have been obvious to have tried the method and pesticides of Furch to treat the insect, i.e. termites of order Isoptera of Mitchell with a reasonable expectation of success, since Furch has shown that the compound of structure (I) has activity against insects that have been found to infest agricultural crops.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612